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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/163,588 09/30/98 JONES

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EXAMINER

PM82/0726

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/163,588

Applicant(s)

JONES, MARTIN KELLY

Examiner

Jacques H. Louis-Jacques

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14, 16-23, 27-32, 35-39 and 41-55 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) 1-11, 13, 14, 16-23, 27-32, 35-39 and 41-55 is/are allowed.

- 6) ☒ Claim(s) _____ is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17. 6) ☐ Other:

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11,13,14,16-23,27-32,35-39 and 41-55 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-30 of copending Application No. 09/395,497. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

3. Claims 1-11, 13-14, 16-23, 27-32, 35-39 and 41-55 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-36 of copending Application No.

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09/163,958. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

4. Claims 1-11, 13-14, 16-23, 27-32, 35-39 and 41-55 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-21, 23-49 of copending Application No. 08/852,119. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on those copending applications since the referenced copending applications and the instant application are claiming common subject matter, as follows: A method for monitoring travel of vehicles and for reporting status of vehicles based on travel data related to the vehicles.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. Claims 1-11, 13-14, 16-23, 27-32, 35-39 and 41-55 are rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 5,623,260 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

6. Claims 1-11, 13-14, 16-23, 27-32, 35-39 and 41-55 are rejected under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent No. 5,657,010 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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7. Claims 1-11, 13-14, 16-23, 27-32, 35-39 and 41-55 are rejected under the judicially created doctrine of double patenting over claims 1-80 of U. S. Patent No. 5,668,543 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patents and is covered by the patents since the patents and the application are claiming common subject matter, as follows: An advance notification system and method utilizing passenger calling report generator.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-11, 13-14, 16-23, 27-32, 35-39 and 41-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross [5,648,770] in view of Bolger [5,168,451].

Ross '770 discloses an apparatus and method of notifying a party of a pending delivery or pickup. A mobile receiver or carrier is equipped with a satellite receiver, a controller and a communicator. The position of the vehicle is determined based on

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positioning data or signals. The controller compares the current vehicle location or position to the location in the mapped area. The communicator then communicates with the user to notify user. As shown in figure 1, there are provided controllers (10 and 21), a video screens or computer displays (14 and 26). Ross '770 also discloses a storage device for storing travel data related to the vehicle. The storage device is mounted on the vehicle located at a remote location. There is also provided a communications device or apparatus for transmitting a message to a controller located at another remote location. The received or transmitted message is indicative of the status (proximity) of the vehicle. As disclosed in column 2, there is provided an analyzer for evaluating the positioning signals to determine the position of the carrier, the position of the carrier is compared with a predetermined location. Also, a time interval is computed, and when the time interval is less than a predetermined time interval, a signal is communication to provide reasonable advance notice. See column 2. Also, a message or notification is forwarded to user via a telephone associated therewith. See columns 5 and 6. As explained, more specifically in the claim section, Ross discloses a voice generator for generating or producing an audible message to notify the party. Ross discloses the time period, and the predetermined distance as the data representative of the proximity of the vehicle. In column 3, Ross '770 discloses the cellular network as a communications device. Further in column 3, Ross '700 discloses the vehicle indicator (identification) and the location indicator. Still in column 3, Ross '770 discloses the communication interface as being telephone interface devices. As an alternate embodiment of the Ross patent, the vehicle can bus a bus and the location indicator is a bus stop. See column 6. However, Ross '770

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does not specifically teach that the user requests is for a specific or particular vehicle, i.e., the request identifying one of the vehicles and a location. Bolger, on the other hand, discloses a user responsive transit system, wherein a user requests information about a specific vehicle of a plurality of fleet vehicles. Based on the user request, a central dispatch controller accesses a database and receives information about the requested vehicle. As shown in figure 7, there are provided a request terminal location (95), a destination location (96) coupled to a service request. As set forth in the specification, the system according to Bolger activates in response to service requests from users. See for example column 3. Thus, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the teachings of Ross by incorporating the features from the user responsive transit system of Bolger because such modification will improve "flexibility and efficiency" of the system.

Information Disclosure Statement

10. The information disclosure statement filed February 20, 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it lacks a statement under 37 CFR 1.97(e) or the required feed under 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the

Under the section "Response to §103 rejections", applicant cited "Applied materials Inc. v. Gemini Research Corp., 15 USPQ.2d 1816, 1818 (Fed. Cir. 1988)", "In re DeBaun, 214 USPQ 933, 935 (CCPA 1982)", MPEP §2136.05 and "In re Mathews, 161 USPQ 276 (CCPA 1969)". to show that the teachings of the prior art applied against the claims are applicant's own work.

Arguments based on these case laws were previously addressed by the examiner in the previous (final) office action. The examiner's positions or interpretations of these case laws are being reproduced below.

Applicant, in citing Applied Materials Inc. v. Gemini Research Corp¹, In re DeBaun², MPEP 2136.05³ and In re Mathews⁴, argued that "the fact that an application has named a different inventive entity that a patent does not necessarily make that patent prior art." The key word is "necessarily". Although, applicant's statement is true, it is not so at all times and in all situations.

The present application was on filed on September 30, 1998 as a continuation of US application 08/852,119 filed on May 6, 1997. The present application names only one inventor, Martin Kelly Jones and is assigned to Global Research System, Inc.

¹ See response at page 12

² See response at page 12

³ See response at page 12

⁴ See response at page 12

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statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Response to Arguments

11. The "Remarks" filed on June 18, 2001 have been entered and carefully considered by the examiner.

Applicant raised the same issues as in the previous remarks. Basically, applicant contented that the examiner cannot use "applicant's own work" as prior art against him. In other words, applicant asserted that the Ross disclosure applied against the claims of the present application is applicant's own work.

The examiner has addressed these issues in the previous office actions. The examiner's position remains the same. The examiner's responses to the various applicant's issues are reproduced below.

As to the double patenting rejections, the examiner disagrees with applicant's position. The mere fact two patents or a patent and an application may have a term that will not exceed any of the terms of each other, is not a basis for not submitting a terminal disclaimer to overcome a double patent rejection.

Applicant is right by mentioning the purpose of a double patenting rejection "as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent". However, applicant left out the other reason as **"to prevent possible harassment by multiple assignees."**

Accordingly all the rejections are sustained and this office action is made final.

The claims of the present application are rejected as being anticipated US Patent 5,5,648,770 issued to John Ross. The '770 patent names only inventor, John Ross, and is assigned to Worldwide Notification Systems, Inc.

US Patent 5,648,770 issued on July 15, 1997, is a continuation of US patent application 08/307,032, which matured as US patent 5,444,44, and which in turn is a continuation of US application 08/062,405, filed on May 14, 1993 which is now abandoned. Thus, the '770 patent has an effective filing date of May 14, 1993.

In reference to Applied Material Inc. v Gemini Research¹, the examiner agrees. However, if the patent has an earlier US effective filing date than the application, such patent is considered to be prior art. In the present case, the present application as filing date of May 6, 1997, while the prior art references have an effective US filing date of may 14, 1993.

The situation in In re DeBaum only applies to the same applicant for the patent and the application. By same applicant, it's meant the same inventive entity. In the present case, the present application names only Martin Kelly Jones, while the applied patents name only John Ross.

As to In re Mathews, one major difference between the present applicant and the In re Mathews' case is that Dewey and Mathews were co-workers. In the present case, there is no showing (other than applicant's statement) that applicant and Ross were co-workers. In fact, let it be known that the US patents to Ross, which named only one inventor, Mr. John Ross, are assigned to Worldwide

Notification Systems, Inc. and the present application, which names only one inventor, Mr. Martin Kelly Jones, is assigned to Global Research systems, Inc.

On page 4 of the response, applicant contended that "there is no requirement that an applicant must establish that is a named inventor of a prior patent to remove the patent as prior art reference via an affidavit/declaration under 37 CFR 1.132." While this may be true, it must clear of record that the patent application and the prior art reference is commonly owned or assigned. Which is not the case in the present situation. Not only the present application and the prior art reference name different inventors and different inventive entities, they are not commonly owned or assigned.

Applicant further argued that "there is no requirement in MPEP 2136.05 for the applicant be named as an inventor in the prior US patent". While this may be true, the MEPE states that "The fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art." *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 15 USPQ2d 1816 (Fed. Cir. 1988). However, the MPEP continues by stating "[T]he issue turns on what the evidence of record shows as to who invented the subject matter." Furthermore, the MPEP states that "applicant may overcome a prima facie case based on the patent by showing that the patent disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee was associated with applicant (e.g. *worked for the same company*) and learned of applicant's invention from applicant." In the case of *In re Land and Rogers* used by applicant, it is noted that *the inventors worked for the same company (Polaroid) and in the same laboratory*. Even they worked for the same company, as the MPEP

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mentions, "The court affirmed the rejection because (1) the inventive entities of the patents (one to Rogers and one to Land) were different from the inventive entity of the joint application (Rogers and Land) and (2) Land and Rogers brought their knowledge of their individual work with them when they made the joint invention. *There was no indication that the portions of the references relied on disclosed anything they did jointly. Neither was there any showing that what they did jointly was done before the filing of the reference patent applications.*"

While MPEP 2136.05 does not mention that the applicant has to be named as an inventor in a prior US Patent to remove this reference as prior art by an affidavit/declaration, MPEP 715 only refers to "joint application or patent" or "commonly owned application or patent."

Finally, as stated in MPEP 716, "It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection are responsive to the rejection and present sufficient facts to overcome the rejection."

Accordingly, the rejections of claims 1-11, 13, 14, 16-23, 27-32, 35-39 and 41-55 are sustained.

Followings are the remaining portions of the previous office action.

Applicant can filed an affidavit to overcome the rejection. However, this can only happen in the case where i) applicant is one of a group of inventors of the patent or ii) the application and the patent are assigned to the same assignee. In the present case, the present application names only one inventor, Martin Kelly

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Jones and the '770 patent name sonly one inventor, John Ross. In order for condition i) above to apply, the '770 patent in question must have Martin Kelly Jones as one of its inventors. In addition, the present application is assigned to Global Research Systems, Inc. while the '770 patent is assigned to Worldwide notification Systems, Inc. In the case of the present situation, the patent applied against the claims of the present application Ross [5,648,770], both of which names only one inventor John Ross and is assigned to Worldwide Notifications Systems, Inc. Therefore, neither condition i) nor condition ii) applies.

Applicant submitted a plurality of exhibits in support to show that the subject matter disclosed by Ross and used in the office action to reject the claims is the product of applicant's own previous work. Applicant then asserts that the Ross patent is not prior art.

The mere fact that applicant has submitted several exhibits including a declaration filed by applicant stating that applicant is a "co-inventor" of the patents to Ross and that applicant invented the subjet matter disclosed in the patents to Ross, is not a basis to remove the Ross patents as prior art and withdrawn the rejections.

The examiner has considerd and reviewwd all the documents (exhibits) presented before him. However, based on the limited information presented herein, the examiner is not able to make a decision as to withdrawn the rejections. Applicant would need a disclaimer from Mr. Ross and/or the assignee of the Ross

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patents affirming that applicant's statement is true or any other evidence showing such.

As to the essence of the rejection itself, applicant argued that the '770 patent to Ross does not disclose all the limitations of the claimed invention. Applicant contended that the '770 patent does teach the request from the user to activate the system.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H. Louis-Jacques whose telephone number is (703) 305-9757. The examiner can normally be reached on M-Th, 8:30 AM - 5:00 PM (Eastern Time).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A. Cuchlinski can be reached on (703) 308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1111.

Jacques H. Louis-Jacques
Primary Examiner
Art Unit 3661

/s/ **jlj**
July 25, 2001

Jacques H. Louis-Jacques
JACQUES H. LOUIS-JACQUES
PRIMARY EXAMINER